REMARKS

Claims 1-25 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I.   Rejection of Claims 1-25 Under 35 USC §103(a)

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schneier (Applied Cryptography Second Edition: protocols, algorithms and source code in C, 1996) and Pinkert, *et al.* (Operating Systems: concepts, policies and mechanisms, 1989). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Schneier nor Pinkert, *et al.*, alone or in combination, teach or suggest all the claim limitations as recited in applicants' claimed invention.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally avail-able to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must *teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 1 (and similarly independent claims 9-11 and 16) recites *a method to authenticate a service by making a request to a first party utilizing a first alias and searching a list of aliases associated with the service... then allowing a second party making the request to access the service if a match is found between the first alias and at least one alias in the list of aliases.*

In particular, an aspect of the claimed invention discloses a method to authenticate a service (*e.g.*, Kerberos) by making a request to a domain controller (*e.g.*, first party), searching a list of Service Principal Names (SPNs) associated with the

service, and enabling a second party to access the service if a match is found between the first SPN and at least one other SPN of the list of SPNs. Neither Schneier nor Pinkert *et al.* disclose or suggest such claimed aspects of applicants' invention.

In the Final Office Action dated February 23, 2004, the Examiner contends Schneier, p.567 discloses "wherein the search results for the search match results for the key words are…in which a search match for a first number of the one or more search engines displayed…" However, as previously noted in the Reply to the Office Action dated September 23, 2003, this language is not mentioned on the page cited by the Examiner. Instead, this passage is directed to how a client and server may communicate with each other utilizing Kerberos. Moreover, such quotation is not found elsewhere in the reference.

In addition, Applicants' representative submits that the Examiner's reliance upon Pinkert *et al.* is misplaced, as it is non-analogous art to the subject invention. Pinkert *et al.* is directed to operating systems and corresponding file names. The aliasing taught by Pinkert *et al.* is directed to techniques for naming and organizing files in an operating system and is not related to service authentication as recited in the subject claims. There is no evidence that one skilled in the art of service authentication logically would look to the art of file naming (*e.g.*, aliasing) taught by Pinkert, *et al.* Absent such evidence, the Examiner's reliance upon Pinkert *et al.* is improper.

Moreover, there is no motivation or suggestion to combine the references, Schneier and Pinkert *et al.* to teach the limitations of the subject invention. In order to reject claims in an application pursuant to §103, there must be some logical reason apparent from *positive, concrete evidence* of record which justifies a combination of primary and secondary references. *See In re Lakowski* 871 F.2d 115; 10 U.S.P.Q.2D (BNA) 1397 (Fed. Cir. 1989) citing *In re Regel*, 526 F.2d 1399, 1403 n.6, 188 USPQ 136, 140 n.6 (CCPA 1975). A challenger to the validity of a patent cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the *challenger has the burden to show some teaching or suggestion* in the references to support their use in the particular claimed combination. *See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

The Examiner contends the motivation to combine the cited references exists by stating "users to reference the same physical file by different logical names." (*See* Pinkert, *et al.*, p. 205, ¶8). However, merely providing the definition of an alias from Pinkert, *et al.* does not provide the motivation or suggestion to combine the reference with Schneier. Nowhere does Pinkert, *et al.* mention the use of aliasing in conjunction with the third party authentication protocol disclosed in Schneier. Similarly, there is no mention in Schneier of utilizing aliasing with a third party trusted authentication system, as recited in the subject claims. Thus, the Examiner's burden to show a motivation to combine Pinkert *et al.* with Schneier is not met and the combination of such references is improper.

It appears the Examiner is impermissibly employing 20/20 hindsight with applicants' specification as a roadmap to make the purported combination. The rationale proffered to modify and combine Schneier and Pinkert *et al.* is to achieve benefits identified in applicants' specification, which overcome problems associated with conventional systems and/or methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In the Final Office Action, Examiner states that as "long as [the reference] takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and ***does not include knowledge gleaned only from the applicant's disclosure***, such a reconstruction is proper." In the Final Office Action, there is no evidence that utilizing aliasing in relation to service authentication is gleaned from either reference cited by the Examiner. Rather, the Examiner cites such a combination based solely on the knowledge taught in the subject application. Thus, even by the standard provided by the Examiner, the burden to demonstrate a motivation to combine is found only in the subject invention. As stated in the previous Reply to Office Action, it is the burden of the Examiner to show that there must be some logical reason apparent

from *positive, concrete evidence* of record which justifies a combination of primary and secondary references. *See In re Lakowski* 871 F.2d 115; 10 U.S.P.Q.2D (BNA) 1397 (Fed. Cir. 1989) citing *In re Regel*, 526 F.2d 1399, 1403 n.6, 188 USPQ 136, 140 n.6 (CCPA 1975). A challenger to the validity of a patent cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the *challenger has the burden to show some teaching or suggestion* in the references to support their use in the particular claimed combination. *See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

The alleged motivation to combine Schneier with Pinkert, *et al.* is merely that Pinkert *et al.* teaches the definition of aliasing. This is not enough. The teaching of Pinkert *et al.* is limited to naming and organization of files and, as noted above, does not provide positive, concrete evidence of the motivation to combine Schneier and Pinkert, *et al.* Since the Examiner has not met his burden to show a motivation to combine references, such a combination cannot be properly made. Thus, the subject invention is nonobvious to one of ordinary skill in the art, and this rejection should be withdrawn.

Finally, the combination of Schneier with Pinkert, *et al.* does not teach all the limitations (*e.g.*, elements) of the subject invention. It is essential to consider all elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984); *Jones v. Hardy*, 727 F.2d 1524, 1527-28, 220 USPQ 1021m 1024 (Fed. Cir. 1984).

As discussed previously, the subject invention relates generally to service authentication, and more specifically to utilizing aliasing in relation to service authentication. (p. 1, lines 5, 6). Independent claims 1, 9-11, and 16 recite a method to authenticate a service by making a request to a first party utilizing a first alias and searching a list of aliases associated with the service... then allowing a second party making the request to access the service if a match is found between the first alias and at least one alias in the list of aliases. It is respectfully submitted that the neither Schneier

nor Pinkert *et al.*, singly and/or in combination teach, suggest or make obvious the limitation of employment of aliasing in connection with authentication of a service.

In view of at least the foregoing, it is readily apparent that there is no suggestion or motivation to combine Schneier and Pinkert *et al.*, the references do not make obvious the subject invention and such a combination does not all the limitations recited in independent claims 1, 9-11 and 16 (and claims 2-8, 12-15 and 17-25 which respectively depend therefrom). This rejection should be withdrawn.

II.   Conclusion

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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